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EXAMINER	
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ART UNIT	PAPER NUMBER
3726	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/787,819	KEMPER ET AL.	
	Examiner	Art Unit	
	Marc Jimenez	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-20 and 22-63* is/are pending in the application.

4a) Of the above claim(s) *19,20,22-52 and 59-62* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-18,53-58 and 63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/04 has been entered.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. **Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading**. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
(d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
(e) BACKGROUND OF THE INVENTION.
(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
(f) BRIEF SUMMARY OF THE INVENTION.
(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(h) DETAILED DESCRIPTION OF THE INVENTION.
(i) CLAIM OR CLAIMS (commencing on a separate sheet).
(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claim 2** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 recites that "said workpiece is moved in an axial direction by said at least one roll". However, the at least one roll works the workpiece in a direction that is longitudinal or transverse to a direction of movement of the workpiece. Therefore, if the roll works the workpiece in a direction that is longitudinal to a direction of movement of the workpiece as appears to be shown in fig. 7A-B, it is unclear how the roll would move the workpiece in the axial direction.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1, 2, 4-18, 53-58, and 63** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "and/or" which is confusing and renders the scope of the claims unclear.

Claim 7 recites "opposite signs" in the last line. It is unclear what this limitation encompasses.

Claim 10 recite "opposite signs" in the last line. It is unclear what this limitation encompasses.

Claim 11 recites "the same sign" in the last line. It is unclear what this limitation encompasses.

Claim 15 recites "and/or" in line 5 which is confusing and renders the scope of the claims unclear.

Claim 16 recites "powered in the same direction of rotation" in line 5 which contradicts claim 15 which recites "powered in a different direction of rotation" in the last line.

Claim 53 recites "and/or" in line 4 which is confusing and renders the scope of the claims unclear.

Claim 54 recites "and/or" in line 2 which is confusing and renders the scope of the claims unclear.

Claim 55 recites "and/or" in line 2 which is confusing and renders the scope of the claims unclear.

Claim 56 recites "and/or" in line 3 which is confusing and renders the scope of the claims unclear.

Claim 53 recites "and/or" in lines 3-4 which is confusing and renders the scope of the claims unclear.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 1 and 12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun et al. (5,179,772) in view of Applicant's Admitted Prior Art [AAPA] (page 1, lines 6-7 and lines 23-24).

Braun et al. teach a method for surface treatment of workpieces **4** in which a workpiece **4** is worked at least in part by at least one roll **1** provided at least in part with an outer profile **1c** having the form of annular beads **2** and recesses **11**, comprising the steps of: exposing a treated (col. 1, line 14, "semifinished metallic products" are considered "treated") surface **8a** of the workpiece **4** to compressive stresses (col. 1, lines 15-17, the cutting operation inherently creates compressive stresses), and exposing zones located beneath the treated surface **8a** of the

workpiece **4** to tensile stresses axially and tangentially (the rotational contact of the roll **1** inherently creates "stresses axially and tangentially") through contact with the annular beads **2**, wherein the outer profile **1c** of the at least one roll **1** works the workpiece **4** in a direction that is longitudinal or transverse to a direction of movement of the workpiece **4**.

Braun et al. broadly teaches that the workpiece is "metallic" in col. 3, lines 8-9 instead of the claimed aluminum.

[AAPA] teaches that aluminum is a conventional material that can be used as a metallic material.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Braun et al. with aluminum as the metallic material, in light of the teachings of [AAPA], in order to provide a metallic material that is relatively light weight and has high strength characteristics.

Regarding claim 12, Braun et al. teach that the treated surface **8a** of the workpiece includes at least one flat surface **8a** and is worked by at least one roll **1** provided at least in part with ah outer profile **1c** arranged substantially perpendicular or at an angle to the workpiece **4** and rotatable about the longitudinal centerline thereof.

Regarding claim 13, Braun et al. teach that the workpiece **4** is supported by at least one further roll (col. 4, line 24, "roller table") provided at least in part with a non-profiled roll spaced away form the at least one roll **1**.

Regarding claim 14, Braun et al. teach that at least one flat surface **8a** to be treated of the workpiece **4** is worked by the at least one roll **1** including an outer profile **1c** in the form of annular beads **2** and recesses **11**.

8. **Claims 15-17 and 63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun et al. in view of [AAPA] as applied to claim 14 above, and further in view of Tinfow et al. (3,845,533).

Braun et al./[AAPA] teach the invention cited with the exception of the workpiece being treated by several rolls powered in a different direction of rotation.

Tinfow et al. teach a workpiece **14** treated by several rolls **32,52** powered in a different direction of rotation and which are axially staggered relative to each other (as applied to claim 17).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Braun et al./[AAPA] with the workpiece being treated by several rolls powered in a different direction of rotation and which are axially staggered relative to each other, in light of the teachings of Tinfow et al., in order to process both sides of the workpiece.

Regarding claim 17, Braun et al. teach that the beads **2** are arranged perpendicular to their longitudinal centerlines.

9. **Claims 1, 2, 4, 6-11, 18, 53, 54, 58, and 63** are rejected under 35 U.S.C. 103(a) as being unpatentable over [AAPA] (page 1, second full paragraph of applicant's specification) in view of Abramsen (4,185,484).

[AAPA] teaches that it is known to surface treat workpieces of aluminum and/or alloyed

aluminum (page 1, lines 6-7) in which the workpiece is worked at least in part (page 1, lines 23-24) including exposing a treated surface of the workpiece to compressive stresses (page 1, line 9).

However, [AAPA] does not specifically teach that the workpiece is worked at least in part by at least one roll provided at least in part with an outer profile having the form of annular beads and recesses, comprising the steps of: exposing zones located beneath the treated surface of the workpiece to tensile stresses axially and tangentially through contact with the annular beads, wherein the outer profile of the at least one roll works the workpiece in a direction that is longitudinal or transverse to a direction of movement of the workpiece.

Abramsen teaches a workpiece that is worked at least in part by at least one roll **22,24** provided at least in part with an outer profile **30** having the form of annular beads **31** and recesses **33** (col. 6, line 5), comprising the steps of: exposing a treated surface **39** of a workpiece **12** to compressive stresses (col. 1, line 16), exposing zones located beneath the treated surface **39** of the workpiece to tensile stresses axially and tangentially (col. 5, line 29) through contact with the annular beads **31**, wherein the outer profile **30** of the at least one roll **22,24** works the workpiece **12** in a direction that is longitudinal (see fig. 2 and fig. 4 where the treated surface has formed therein lines that are longitudinal to the workpiece axis. Fig. 2 clearly shows longitudinal lines formed on the workpiece **12**) to a direction of movement of the workpiece **12**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA] with the workpiece being worked at least in part by at least one roll provided at least in part with an outer profile having the form of annular beads and recesses, comprising the steps of: exposing zones located beneath the treated surface of the

workpiece to tensile stresses axially and tangentially through contact with the annular beads, wherein the outer profile of the at least one roll works the workpiece in a direction that is longitudinal or transverse to a direction of movement of the workpiece, in light of the teachings of Abramsen, in order to remove scale form the surface of the workpiece.

Regarding claim 2, Abramsen teaches that the workpiece **12** is moved in an axial direction (col. 5, line 27) by the at least one roll **22,24** provided with the annular beads **31**.

Regarding claim 4, Abramsen teaches that the workpiece has a round treated surface **39** and is worked by at least one roll **22,24** provided at least in part with an outer profile **30** arranged parallel (see fig. 4) to the workpiece **12** and is rotatable about the longitudinal centerline thereof as well as about the workpiece **12**.

Regarding claim 6, Abramsen teaches that the workpiece **12** is worked by a roll **22,24** provided at least in part with an outer profile **30** and at least two, substantially non-profiled rolls **44,46** arranged about the workpiece **12**.

Regarding claim 7, Abramsen teaches that the workpiece is worked by a roll **22,24** having an outer profile **30** in the form of annular beads and recesses arranged at a first angle and a second angle to the longitudinal centerline of the roll **22,24** wherein the first angle and the second angle have opposite signs. The first and second angles could be any angle on the surface of the beads. For example, the beads have an angle going up to the apex of the beads and an angle going down towards the base of the beads.

Regarding claim 8, Abramsen teaches that the workpiece **12** is worked by two rolls **22,24** each provided at least in part with an outer profile **30** and a substantially non-profiled roll **44,46**

arranged about the workpiece **12**. Claim 8 is written in alternative language, therefore, "or in said at least one bore" is not required.

Regarding claim 9, Abramsen teaches that the workpiece **12** is worked by two rolls **22,24** having an outer profile **30** in the form of annular beads **31** and recesses **33** arranged at an angle to the longitudinal centerlines of the rolls **22,24,44,46**.

Regarding claim 10, Abramsen teaches that the two rolls **22,24** are powered in the same direction of rotation (counterclockwise in fig. 4) when the annular beads **31** and recesses **33** arranged at a first angle and a second angle to the longitudinal centerlines of the two rolls **22,24** wherein the first angle and the second angle have opposite signs.

Regarding claim 11, Abramsen teaches that the two rolls **22,24** are powered in the opposite direction (col. 6, lines 24-25) of rotation when the annular beads and recesses are arranged at a first angle and a second angle to the longitudinal centerlines of the two rolls wherein the first angle and the second angle have the same sign. Regarding claims 10 and 11, Abramsen teach the invention as claimed because the rotation of Abramsen could be considered to be rotation in the same direction (ie. same counterclockwise direction or opposite direction as in col. 6, lines 24-25). Furthermore, at the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used the same or opposite roll rotation directions because applicant has not disclosed that either type of rotation provides an advantage, is used for a particular purpose, or solves a stated problem over the other type of rotation. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the rotation taught by Abramsen or the claimed rotation

direction because either direction of rotation perform the same function of working the surface of the workpiece equally well.

Regarding claim 18, Abramsen teaches that the workpiece **12** is coated with a covering material (col. 8, lines 30-31). Although, Abramsen broadly teaches coating and not specifically that the coating is of metal, metal alloy, a paint, a plastics, is anodized, galvanized, or pickled, official notice is taken that these coating techniques are well known in the art to provide a suitable coating that protects the workpiece.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA] with the specifics of claims 2, 4, 6-11, and 18, in light of the teachings of Abramsen, in order to order to remove scale form the surface of the workpiece.

Regarding claims 53 and 58, [AAPA] teaches using aluminum (page 1, line 7).

Regarding claim 54, Abramsen teaches a rod. [AAPA] also teach rods.

10. **Claims 5 and 56** are rejected under 35 U.S.C. 103(a) as being unpatentable over [AAPA] in view of Abramsen as applied to claim 1 above, and further in view of McQueen (5,460,563).

[AAPA] teaches that openings such as through-holes and/or blinds holes have surface treatment (page 1, lines 24-25). However, [AAPA] does not specifically teach working the at least one bore with at least one roll provided with an outer profile arranged parallel to the at least one bore and which is rotatable about the longitudinal centerline as well as about the bore.

McQueen teaches working at least one bore with at least one roll **10** provided with an outer profile **26** arranged parallel to the at least one bore and which is rotatable about the longitudinal centerline as well as about the bore.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA]/Abramsen with working the at least one bore with at least one roll provided with an outer profile arranged parallel to the at least one bore and which is rotatable about the longitudinal centerline as well as about the bore, in light of the teachings of McQueen, in order to accurately finish the interior surfaces of the workpiece.

11. **Claim 54** is rejected under 35 U.S.C. 103(a) as being unpatentable over [AAPA] in view of Abramsen as applied to claim 1 above, and further in view of Russell (6,062,645).

[AAPA]/Abramsen teach the invention cited with the exception of using the workpiece for headrest brackets in automobiles. It is noted however, that the workpieces of [AAPA] and Abramsen produce stock materials that can be made into different shapes in further processing operations.

Russell teaches that it is known to use metal for headrest brackets **11** in automobiles.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA]/Abramsen with using the workpiece for headrest brackets in automobiles, in light of the teachings of Russell, in order to make a structural support for an automobile seat.

12. **Claim 55** is rejected under 35 U.S.C. 103(a) as being unpatentable over [AAPA] in view of Abramsen as applied to claim 1 above, and further in view of Shiau (4,640,500).

[AAPA]/Abramsen teach the invention cited with the exception of using the workpiece coiled springs. It is noted however, that the workpieces of [AAPA] and Abramsen produce stock materials that can be made into different shapes in further processing operations.
Shiau teaches that it is known to use metal for coiled springs **11**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA]/Abramsen with using the workpiece for coiled springs, in light of the teachings of Shiau, in order to create a shock absorber for automobiles.

13. **Claim 57** is rejected under 35 U.S.C. 103(a) as being unpatentable over [AAPA] in view of Abramsen as applied to claim 1 above, and further in view of Fredrick (5,671,976).

[AAPA]/Abramsen teach the invention cited with the exception of using the workpiece for headrest brackets in automobiles having at least one flat surface. It is noted however, that the workpieces of [AAPA] and Abramsen produce stock materials that can be made into different shapes in further processing operations.

Fredrick teaches that it is known to use metal for headrest brackets **20** in automobiles that have at least one flat surface.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA]/Abramsen with using the workpiece for headrest brackets in automobiles, in light of the teachings of Russell, in order to make a structural support for an automobile seat.

Response to Arguments

14. Applicant's arguments filed 5/5/04 have been fully considered but they are not persuasive.

15. Applicant argues that Abramsen does not disclose that it is either necessary or desirable to place the treated surface of the round stock under compressive stresses, while placing areas of the round stock lying below the treated surface under tensile stresses. It is noted however, that the round stock is considered a treated workpiece which is hot rolled. The hot rolling corresponds to the claimed "compressive stresses". The round stock is then placed under tensile stresses by contact with the rolls **22,24**. Applicant shows rollers which contact the outer surface of the workpiece in the drawings, similarly, Abramsen shows rollers **22,241** which contact the outer surface of the workpiece **12**. It is inherent that tensile stresses are created on the round stock of Abramsen as applicant also describes on page 2, lines 10-17 of applicant's specification.

16. Applicant argues that even if in the first stage the round stock of Abramsen were placed under compressive and tensile stresses axially and tangentially, the compressive and tensile stresses would be removed in a third stage. It is noted however, that the claims do not preclude additional steps. In response to applicant's argument that the reference includes additional structure not required by applicant's invention, it must be noted that the reference discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

17. Applicant argues that Abramsen does not teach that the roll works the workpiece in a direction that is longitudinal or transverse to a direction of movement of the workpiece. It is

noted however, that in fig. 2, Abramsen clearly shows that the rolls **22,24** create longitudinal lines on the workpiece **12** (fig. 2). The rolls **22,24** clearly rotate about the workpiece **12**.

18. Applicant's arguments regarding claims 2, 6-11, 18, and 53-58 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Contact Information

19. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
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If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http:www.uspto.gov/

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MJ
May 15, 2004